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Paper No. **64**
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Christopher Wade

v.

Riles & Company

Cancellation No. **21,869**

David J. Davis of Baker & McKenzie for Christopher Wade.

David R. Shaub of Shaub & Williams for **Riles & Company, Inc.**

Before **Quinn**, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

On June 2, 1993, Christopher Wade, an individual, filed a petition to cancel a registration assigned to Riles & Company, Inc., ("Riles"), a California corporation, for the mark THREE-PEAT for "shirts, jackets and hats."¹

Petitioner alleges in the petition that he sells t-shirts and other apparel items and that he has "a bona fide intent"

¹ Registration No. 1,552,980; issued August 22, 1989; Section 8 affidavit accepted. The underlying application was filed by P.d.P. Paperon de Paperoni S.p.A. and was assigned to Riles in May 1989.

to produce and sell apparel which includes the word THREE-PEAT as part of the ornamental design. Petitioner also alleges that THREE-PEAT has become a generic slang word meaning "to perform an action or feat three consecutive times" particularly in relation to athletic events; that the designation is an informational and ornamental feature of respondent's goods and does not function as a mark; that the designation is generic or descriptive as used on respondent's goods and has not acquired distinctiveness; that the designation has been abandoned as the result of an invalid assignment of the underlying application to Riles by the former owner of the mark; and that the designation has been abandoned as the result of nonuse by respondent for a period of at least two years.

Respondent admits that the underlying application was assigned to Riles and denies the remaining allegations.

Petitioner did not take any testimony but filed a notice of reliance on printed publications consisting of stories retrieved from the NEXIS database purporting to show generic and informational use of THREE-PEAT; respondent's responses to certain interrogatories; documents including copies of representative license agreements between petitioner and

Although the assignment was recorded in the Office on July 11, 1989,

various companies for the use of THREE-PEAT on goods such as hats and t-shirts, copies of "apparel designs" for the asserted mark, and correspondence "produced by Registrant during discovery" to illustrate the ways in which THREE-PEAT is "used or proposed to be used" by respondent on its goods.² (Petitioner's brief, p. 3-4).

Respondent in turn filed a notice of reliance on petitioner's responses to certain discovery requests and printed publications obtained from the WESTLAW and NEXIS databases to show public recognition of THREE-PEAT as a mark. In addition, respondent submitted the testimony (with exhibits) of Bijan Khezri, former president of P.d.P. Paperon De Paperoni, the original owner and assignor of the underlying application to Riles; Christine Riley, vice-president and director of respondent; and respondent's financial consultant and business manager, John Aldrich, an account manager for AYCO Company, LP.³ The exhibits introduced during the examination of Mr. Aldrich include a declaration of Christopher Wade dated July 14 1994, duplicates of the

the registration issued in the name of the original owner.

² None of these documents is proper subject matter for a notice of reliance. See, for example, Trademark Rules 2.120(j)(3)(ii), 2.122(e), and TBMP § 711. However, as explained in footnote 6, *infra*, these materials are being treated as being of record in this case.

³ Petitioner did not attend any of these depositions.

"apparel designs" previously submitted under petitioner's notice of reliance, and petitioner's own examples of use of THREE-PEAT on shirts.

Both parties filed trial briefs but an oral hearing was not requested.

In his brief, petitioner states that he is a seller of t-shirts, that he intends to sell apparel which includes the word "three-peat" as part of the ornamental design, and that he believes he should not be required to pay a royalty fee to respondent in order to do so. Petitioner argues that the registration for THREE-PEAT should be cancelled "on the grounds that it fails to function as a trademark and is generic." (Brief, p. 13). Petitioner contends that the term serves an informational and ornamental function in view of the "location, size, prominence and significance" of the asserted mark on respondent's goods. (Brief, p. 11). Petitioner relies on the NEXIS evidence to show that the public would view THREE-PEAT as a generic term meaning a third successive accomplishment or to perform an act for a third consecutive time, rather than to identify respondent's apparel. Petitioner contends that respondent's license agreements show that THREE-PEAT is always used in combination with other

parties' trademarks such as "CHICAGO BULLS" and "BUFFALO BILLS" and that the "representative" apparel designs show that the combined designation is used in an ornamental and informational manner. Petitioner maintains that as a result of the use of THREE-PEAT with numerous other parties' trademarks, consumers would not be able to associate THREE-PEAT with any particular source and instead would believe that the clothing on which it is used originates from different entities such as the source of, for example, a CHICAGO BULLS shirt. Petitioner further argues that the use of these third-party marks creates the demand for the goods contending that THREE-PEAT alone without any other mark "would not be perceived as an indicator of the source of the t-shirt."⁴ (Brief, p. 12).

Respondent maintains that no evidence has been submitted to support petitioner's claim that he is a competitor of respondent or that he has an intention to use THREE-PEAT on apparel. Noting that petitioner "filed no testimony" in this case, respondent argues that "[f]or this reason alone, the Petition should be dismissed" because the "failure to present testimony is a failure to prove the case-in-chief." (Brief,

⁴ Although petitioner also pleaded claims of descriptiveness, lack of acquired distinctiveness, and abandonment on two grounds, none of

p. 10). Respondent points to its own testimony and evidence showing that THREE-PEAT is a coined term which is recognized as a mark, and contends that although the term may be commonly used by media, respondent has controlled the use of THREE-PEAT as a trademark. Respondent argues that THREE-PEAT is not generic for its goods and contends that the numerous media stories as well as its own evidence of use demonstrate that the term functions as a mark and is recognized as an identification of source.⁵

We turn first to the issue of standing. Petitioner has not taken any testimony nor properly introduced any evidence to prove his standing in this case. Nevertheless, and quite surprisingly, petitioner's standing has been established by evidence made of record by respondent. This evidence consists of a declaration of Christopher Wade which was submitted by petitioner in support of an earlier motion for summary judgment in this case. Ordinarily, evidence submitted in connection with a motion for summary judgment is not

those claims were pursued or argued in petitioner's brief and have therefore been considered dropped from the case.

⁵ Mr. Aldrich has testified as to respondent's ownership of at least two other registrations for THREE-PEAT for goods including collector plates, mugs and key chains. Since respondent did not establish the current status of those registrations, the registrations are not properly of record and have not been considered. See Trademark Rule 2.122(d)(2) and, generally, TBMP § 703.02(a).

considered of record for purposes of the final decision in a case unless properly introduced at trial. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998) and TBMP § 528.05(a). In this case, respondent has made Mr. Wade's declaration of record by introducing it as an exhibit to the testimony of Mr. Aldrich. Having been properly introduced into evidence, the declaration may be referred to or relied upon by either party for any purpose permitted by the applicable rules.

Mr. Wade states in his declaration that he is a seller of t-shirts and other apparel and that he is entitled to use the term in an ornamental fashion on his goods. Respondent, however, maintains that the declaration "is no longer valid because the declaration is dated July 14, 1994" and that "[I]t no longer can be assumed that Mr. Wade presently intends to compete with Riles & Co., currently sells apparel items which display designs and terms relating to sporting events and teams, [or] ... still intends to produce, distribute and sell apparel which includes the words 'THREE-PEAT'...." (Respondent's brief, p.5).

The purpose of the standing requirement is to prevent mere intermeddlers from initiating proceedings. Thus, to meet this requirement, a plaintiff need only show that it has a real interest in the outcome of the proceeding. See *Ritchie*

v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

Petitioner's interest in this case is established by the uncontroverted statement in petitioner's declaration to the effect that he is engaged in the sale of the same goods as respondent. See, e.g., Eastman Kodak Co. v. Bell & Howell Document Management Products Co., 23 USPQ2d 1878 (TTAB 1992), aff'd 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993).

Respondent has relied on petitioner's responses to interrogatories presumably to show that petitioner has not established any "intention" to use the term THREE-PEAT in connection with any goods. However, for purposes of standing, petitioner does not need to prove an intention, or even an interest, in using the asserted mark on his own goods. See, e.g., Jewelers Vigilance Committee, Inc. v. Ullenberg Corp., 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). It is only necessary that he has a right to use the asserted mark in his business. This right is presumed from petitioner's status as a competitor of respondent. See Plyboo America Inc. v. Smith & Fong Co., 51 USPQ2d 1633 (TTAB 1999).

We turn then to the merits of the petition. Petitioner has the burden of proving his claims that THREE-PEAT is generic and otherwise fails to function as a mark. Although petitioner has taken no testimony, he has properly introduced certain evidence in support of his case by way of notice of

reliance.⁶ However, the evidence as a whole is insufficient to sustain petitioner's burden.

To begin with, the generic meaning of a mark is not determined in a vacuum but rather in relation to the goods on which it is used. See, for example, *In re Abcor Development Corp., Inc.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Notwithstanding that the NEXIS articles may show that THREE-PEAT is widely used by the media to denote a type of athletic accomplishment, there is no indication that this term conveys any meaning, let alone generic meaning, about respondent's goods.

See, for example, *In re Classic Beverage Inc.*, 6 USPQ2d 1383 (TTAB 1988). There is no indication that the term has anything other than arbitrary significance with respect to those goods.

⁶ Contrary to respondent's apparent contention, petitioner's NEXIS evidence, to the extent that it consists of articles published in newspapers or magazines of general circulation, was properly made of record by notice of reliance. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). Moreover, the NEXIS material is not hearsay since it is not relied on by petitioner for the truth of the statements made in the articles but rather to show the context of use of the term by the media. We also note that respondent itself has introduced the same type of evidence by notice of reliance.

To the extent that respondent has objected to the introduction of other evidence submitted by petitioner under a notice of reliance, and although such evidence, as noted earlier, was improperly offered by petitioner, the evidence has been considered by the Board since respondent has either relied on or introduced the evidence as part of its own case. See, generally, TBMP §§ 708 and 711.

Moreover, petitioner has failed to show that the term is not used in the manner of a mark or that it otherwise would not be perceived as a mark indicating source. Petitioner has failed to produce any evidence that THREE-PEAT is used in an ornamental manner or that the term is an inseparable part of other marks or designs on respondent's goods. In fact, petitioner has submitted no evidence whatsoever of use of THREE-PEAT on goods. Although Mr. Aldrich admits that one of the apparel designs relied on by petitioner had been approved for use, there is no evidence that any of the designs were ever actually used on or applied to any goods.

In any event, respondent has submitted media articles demonstrating recognition of THREE-PEAT as a trademark and clear evidence of use of THREE-PEAT as a mark. In one such example, the term THREE-PEAT is applied to the front pocket of a polo shirt where its size and placement on the shirt clearly demonstrates use in the manner of a mark. There is nothing in the record to establish that the term used in this manner would not be recognized as an indication of source.

Finally, the mere fact that respondent has licensed the use of THREE-PEAT to a number of different companies does not, in itself, diminish its ability to identify a single source for respondent's goods. The owner of a trademark is free to license its mark to as many third parties as it chooses, to be

used on goods which it does not itself manufacture, provided the owner controls licensees as to the nature and quality of the goods on which the mark is used. See Sections 5 and 45 of the Trademark Act. Moreover, a mark does not necessarily have to indicate a single physical source for the goods but may also indicate a single, i.e., consistent, source of quality, regardless of the actual physical source or producer of the goods. J.T. McCarthy, *McCarthy on Trademarks and Unfair Competition* § 18:41 (4th ed. 2000) citing *In re Abcor Development Corporation*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978). Petitioner has pointed to nothing in respondent's license agreements or any other evidence which would indicate that the quality of the goods to which the mark is applied is not properly or adequately controlled by respondent.

Thus, petitioner has failed to establish that THREE-PEAT is generic for respondent's goods or that it otherwise would not be perceived as a mark for those goods.

Decision: The petition to cancel is dismissed.